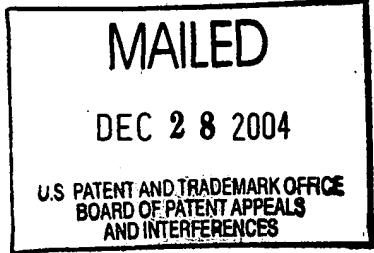


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES



Ex parte ALGIRDAS A. UNDERYS

Appeal No. 2001-0359  
Application No. 08/991,113

ON BRIEF

Before WINTERS, HANLON, and SCHEINER, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

DECISION ON REHEARING

In a decision mailed on May 27, 2004, a panel of the board affirmed the final rejection of claims 4, 6, 7, 15, 16 and 19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,398,885 ("the '885 patent") either alone or in combination with McGinty or Heath. Paper No. 38. In response, appellant filed two papers. The first paper was received on July 26, 2004, and is entitled "REQUEST FOR REHEARING." Paper No. 39. The second paper was received on September 30, 2004, and is entitled "REQUEST FOR EN BANC REHEARING." Paper No. 40.

Appellant's request for rehearing

In the request for rehearing, appellant argues that the panel's reliance on In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998), misapprehends the law. Specifically, appellant argues that Berg does not support the use of a one-way determination of obviousness in the "broad filed first and specific filed later but issues first" context presented in the instant case because the broad claims were not filed first in Berg.<sup>1</sup> Rather, relying on In re Stanley, 214 F.2d 151, 102 USPQ 234 (CCPA 1954), In re Borah, 354 F.2d 1009, 148 USPQ 213 (CCPA 1966), and In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991), appellant argues that he is entitled to a two-way determination of obviousness.<sup>2</sup> See Paper No. 39, pp. 2-3.

Appellant's arguments are not persuasive. Although the Court applied a two-way determination of obviousness in the Stanley and Braat decisions, the primary basis for those decisions, different inventive entities, was removed by the Patent Law Amendments Act of 1984 ("the 1984 Act"). As explained in Berg, 140 F.3d at 1433-34, 46 USPQ2d at 1230:

[The factual situation in Braat] is not likely to be repeated since the 1984 Act went into effect. . . . In Braat the common assignee could not have filed both sets of claims together because the inventive entity named in the application did not

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<sup>1</sup>In Berg, broad and specific claims were filed simultaneously in separate applications. Berg, 140 F.3d at 1430, 46 USPQ2d at 1227.

<sup>2</sup>Appellant argues that In re Calvert, 97 F.2d 638, 38 USPQ 184 (CCPA 1938), is also controlling in this appeal. See Paper No. 39, p. 3. Appellant did not rely on Calvert in either the appeal brief or the reply brief. Therefore, we decline to comment on Calvert at rehearing. See In re Kroekel, 803 F.2d 705, 708-09, 231 USPQ 640, 642-43 (Fed. Cir. 1986) (arguments presented for the first time in a request for reconsideration are not entitled to consideration).

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invent the subject matter of all the patent claims and vice-versa.<sup>4</sup> See Braat, 937 F.2d at 594, 19 USPQ2d at 1293.

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<sup>4</sup>Both applications were filed before the 1984 Act took effect. Prior to the 1984 Act, inventors could not apply jointly unless each made an inventive contribution to the subject matter of every claim. Under the 1984 Act, 35 U.S.C. § 116 was amended so that "[i]nventors may apply for a patent jointly even though . . . each did not make a contribution to the subject matter of every claim."

Similarly, in Stanley, the common assignee could not have filed claims to the generic invention and claims to the specific invention in the same application because the inventors of the generic invention were not the inventors of the specific invention and vice-versa. Stanley, 214 F.2d at 153, 102 USPQ at 236.

In Borah, the Court determined that the two-way test was appropriate because the applicant could not avoid separate filings and the USPTO controlled the rates of prosecution to cause the later filed species claims to issue before the earlier filed genus claims. Borah, 354 F.2d at 1011, 1016, 148 USPQ at 215, 219.

Consistent with the decision in Borah, the Court in Berg explained that the two-way test is a narrow exception to the general rule of the one-way test and applies when:

[T]he applicant could not avoid separate filings, and even then, only if the PTO controlled the rates of prosecution to cause the later filed species claims to issue before the claims for a genus in an earlier application. This was the situation in Borah.

Berg, 140 F.3d at 1435, 46 USPQ2d at 1232.

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The Manual of Patent Examining Procedure § 804(II)(B)(1)(b) (8th ed., Rev. 2, May 2004), further describes the application of the two-way test as follows:<sup>3</sup>

If the patent is the later filed application, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed. A two-way test is to be applied only when the applicant could not have filed the claims in a single application and there is administrative delay. *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998) ("The two-way exception can only apply when the applicant could not avoid separate filings, and even then, only if the PTO controlled the rates of prosecution to cause the later filed species claims to issue before the claims for a genus in an earlier application . . . ."). In the absence of administrative delay, a one-way test is appropriate. . . . Unless the record clearly shows administrative delay by the Office and that applicant could not have avoided filing separate applications, the examiner may use the one-way obviousness determination and shift the burden to applicant to show why a two-way obviousness determination is required.

In the final decision, this panel stated (Paper No. 38, p. 7):

[A] review of the record by this panel reveals that the USPTO did not "control the rates of prosecution" of the instant application and the application which matured into the '885 patent to cause the claims of the '885 patent to issue before the claims of the instant application. To the contrary, it appears that any delay in the prosecution of the instant application is attributable to appellant. [Footnote omitted.]

In the request for rehearing, appellant offers reasons for his delay in prosecuting the instant application.<sup>4</sup> However, any explanation relating to appellant's delay is irrelevant. Where,

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<sup>3</sup>See *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1439, 221 USPQ 97, 107 (Fed. Cir. 1984) ("The MPEP has no binding force on us, but is entitled to notice, so far as it is an official interpretation of statutes or regulations with which it is not in conflict.").

<sup>4</sup>To support his argument, appellant proffers, for the first time in the request for rehearing, a photocopy of two pages of notes (Attachment A) said to summarize several telephone

(continued...)

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as here, the record does not clearly show administrative delay by the Office, appellant must show that the USPTO controlled the rates of prosecution in the instant application and the application which matured into the '885 patent to cause the claims of the '885 patent to issue before the claims of the instant application. See Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (discussing administrative delay as an unusual circumstance where the PTO is solely responsible for the delay in causing the second-filed application to issue prior to the first).

In the request for rehearing, it is not entirely clear that appellant is arguing that the USPTO controlled the rates of prosecution to cause the claims of the '885 patent to issue before the claims of the instant application. However, to the extent that appellant is making that argument at rehearing, the argument was not raised in either the appeal brief or the reply brief. Therefore, it is not properly before us at rehearing. See Kroekel, 803 F.2d at 708-09, 231 USPQ at 642-43 (arguments presented for the first time in a request for reconsideration are not entitled to consideration) See Moller v. Harding, 214 USPQ 730, 731 (Bd. Pat. Int. 1982), aff'd mem., 714 F.2d 160 (Fed. Cir. 1983) ("a party cannot wait until after the board has rendered a decision against him and then present new contentions in a request for reconsideration").

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<sup>4</sup>(...continued)

conversations with USPTO personnel in February 2002 and activity in March 2002. See Paper No. 39, pp. 7-8. This evidence was not timely submitted. Therefore, it is not properly before us at rehearing. See 37 CFR § 1.195 (2003); see also 37 CFR § 41.52(a)(1) (2004); Campbell v. Wettstein, 476 F.2d 642, 648, 177 USPQ 376, 380 (CCPA 1973) (no consideration given to documents inasmuch as the documents were not submitted in a timely manner).

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In sum, appellant has failed to establish that we misapprehended or overlooked any point in rendering our decision. See 37 CFR § 1.197(b) (2003); see also 37 CFR § 41.52(a)(1) (2004). Therefore, we decline to modify the "DECISION ON APPEAL" mailed on May 27, 2004, in any respect.

Appellant's request for en banc rehearing

Appellant also filed a "REQUEST FOR EN BANC REHEARING." Paper No. 40. That paper is not entitled to consideration for two reasons.

First, an appellant is only entitled to a "single" request for rehearing. See 37 CFR § 1.197(b) (2003); see also 37 CFR § 41.52(a)(1) (2004). Appellant's "REQUEST FOR EN BANC REHEARING" constitutes a second request for rehearing.

Second, a request for rehearing must be filed within two months from the date of the original decision. See 37 CFR § 1.197(b) (2003); see also 37 CFR § 41.52(a)(1) (2004). The original decision was mailed on May 27, 2004, and appellant's "REQUEST FOR EN BANC REHEARING" was received in the USPTO more than two months later on September 30, 2004. Therefore, the "REQUEST FOR EN BANC REHEARING" was not timely filed. See 37 CFR § 1.6(a) (2003).

Conclusion

Appellant's "REQUEST FOR REHEARING" has been granted to the extent that the "DECISION ON APPEAL" mailed on May 27, 2004, has been reconsidered. However, the

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request is denied because we decline to modify the decision in any respect. Furthermore, appellant's "REQUEST FOR EN BANC REHEARING" is dismissed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (2004).

REHEARING DENIED

*Sherman D. Winters*

SHERMAN D. WINTERS  
Administrative Patent Judge

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BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

*Adriene Lepiane Hanlon*  
ADRIENE LEPIANE HANLON  
Administrative Patent Judge

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*Toni R. Scheiner*  
TONI R. SCHEINER  
Administrative Patent Judge

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JAMES G. STAPLES ESQ  
A. FINKL & SONS CO  
2011 NORTH SOUTH PPORT AVENUE  
CHICAGO, IL 60614